

Remarks

Applicants respectfully request reconsideration of the present U.S. Patent application as amended herein. Claims 1 and 14 have been amended. Claim 2 has previously been canceled. Thus, claims 1 and 3-45 are pending.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 1, 3, 4, 14, 17, 22, 28 and 37-45 were rejected as being unpatentable over U.S. Patent No. 5,848,413 issued to Wolff, et al. (*Wolff*) in view of U.S. Patent No. 5,978,477 issued to Hull, et al. (*Hull*) and further in view of U.S. Patent No. 6,584,508 issued to Epstein, et al. (*Epstein*) and further in view of U.S. Patent No. 6,742,116 issued to Matsui (*Matsui*). For at least the reasons set forth below, Applicants submit that claims 1, 3, 4, 14, 17, 22, 28 and 37-45 are not rendered obvious by *Wolff*, *Hull*, *Epstein* and *Matsui*.

Claim 1 recites:

a multifunction machine to supply multiple electronic documents that have been saved in the absence of an explicit command by a user to save the electronic documents and in response to another user specified function associated with the electronic documents;

a filter coupled with the multifunction machine to transform one or more of the electronic documents to meet predetermined content-based standards if the one or more electronic documents do not meet the standards for publication; and

a server coupled to the filter and to the multifunction machine, the server having memory to store the multiple electronic documents, the server to select and to publish a subset of electronic documents by selectively permitting access to the subset of electronic documents, the server further to transmit authorization information to one or more recipients, the authorization information to enable the one or more recipients to access one or more of the subset of electronic documents.

Thus, Applicants claim a server that selects a subset of documents that have been captured by the multifunction machine and transformed by the filter if the captured documents do not meet predetermined standards.

Claim 14 similarly recites publishing a subset of captured electronic documents that have been transformed if the captured documents do not meet predetermined standards. Claim 17 similarly recites a server allowing access to a selected subset of captured electronic documents that have been transformed if the captured documents to not meet predetermined standards. Claim 22 is a means-plus-function claim that recites means for allowing access to a selected subset of captured electronic documents that have been transformed if the captured documents to not meet predetermined standards. Claim 28 is an article of manufacture claim that recites allowing access to a selected subset of captured electronic documents that have been transformed if the captured documents to not meet predetermined standards.

Something in the prior art must suggest the desirability, and thus the obviousness, of making the combination proposed in an Office Action. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434, 1438 (CAFC 1988). Although an Office Action may suggest that an element of a primary prior art reference *could* be modified in view of a secondary prior art reference to form the claimed structure, the mere fact that the prior art *could* be so modified would not make the modification obvious unless the prior art suggested the desirability of the modification (emphasis added). In re Laskowski, 871 F.2d 115, 10 USPQ2d 1297 (CAFC 1989). There must be some

supporting teaching in the prior art for the proposed combination of references to be proper. In re Newell, 891 F.2d 899, 13 USPQ2d 1248 (CAFC 1989).

The Office Action merely states that it would have been obvious to one of ordinary skill in the art to modify the references as set forth in the Office Action. There is no citation in the Office Action to any teaching or suggestion in the cited references to support the obviousness of the modification and/or combination set forth in the Office Action. Therefore, Applicants submit that obviousness rejection in the Office Action mailed September 9, 2004 is incomplete.

Applicants are further concerned that the references have been combined with the benefit of hindsight. Hindsight must be avoided in combining reference elements. Panduit Corp v. Dennison Manufacturing Co., 774 F.2d 1082, 227 USPQ 337, 343 (CAFC 1985); In re Find, 837 F.2d 1071, 5 USPQ2d 1596 (CAFC 1988). It is error to reconstruct a patentee's claimed invention from the prior art by using the patentee's claim as a blueprint. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (CAFC 1983), cert. denied, 469 U.S. 851 (1984). "When prior art references require selective combination . . . to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself." Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543, 551 (CAFC 1985).

Notwithstanding the lack of motivation combine and the possible use of hindsight analysis, the cited reference fail to disclose the invention as claimed in claims 1, 14, 17, 22 and 28. For example, the Office Action does not identify a reference as teaching or suggesting a server that selects a subset of captured documents to be published. Also, the

purposes of the authorization information as disclosed by *Matsui* is different that the claimed use of authorization information, but the Office Action does not provide a motivation or suggestion on the applicability of *Matsui* to publication of captured documents other than the “feature would also be advantageous...” and therefore obvious.

Claims 3, 4, 29, 30 and 37-39 depend from claim 1. Claims 31 and 32 depend from claim 14. Claims 33, 34 and 40-42 depend from claim 17. Claims 35, 36 and 43-45 depend from claim 28. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 3, 4 and 31-45 are not rendered obvious by *Wolff*, *Hull*, *Bauer* and *Matsui* for at least the reasons set forth above.

Claims 8-13, 15, 16, 18, 23 and 27 were rejected as being unpatentable over *Wolff* in view of *Hull* and further in view of U.S. Patent No. 6,188,673 issued to Bauer, et al. (*Bauer*). Claims 8-13 depend from claim 1. Claims 15 and 16 depend from claim 14. Claim 18 depends from claim 17. Claims 23 and 27 depend from claim 22.

Bauer is cited to teach maintaining access logs on a server that provides access to electronic documents. Whether or not *Bauer* discloses access logs, nothing in *Bauer* teaches or suggests sending authorization information to recipients as discussed above. Therefore, *Bauer* does not cure the deficiencies of *Wolff* and *Hull*. Thus, no combination of *Wolff*, *Hull* and *Bauer* can teach or suggest the invention as claimed in claims 8-13, 15, 16, 18, 23 and 27.

Claims 5-7, 19-21 and 24-26 were rejected as being unpatentable over *Wolff* in view of *Hull* and further in view of U.S. Patent No. 6,317,777 issued to Skarbo, et al. (*Skarbo*). *Skarbo* is cited to teach auto-deletion of an electronic document. Whether or

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not *Skarbo* discloses auto-deletion, *Skarbo* does not cure the deficiencies of *Wolff* and *Hull* as described above. Therefore, no combination of *Wolff*, *Hull* and *Skarbo* teaches or suggests the invention as claimed in claims 5-7, 19-21 and 24-26.

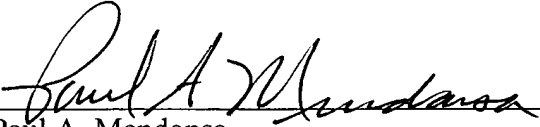
Conclusion

For at least the foregoing reasons, Applicants submit that the rejections have been overcome. Therefore, claims 1 and 3-45 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,
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